



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,825	08/17/2001	Rene Staub	182-99-PCT/U	6272

23869 7590 10/26/2004

HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

EXAMINER

COLIN, CARL G

ART UNIT PAPER NUMBER

2136

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,825

Applicant(s)

STAUB ET AL.

Examiner

Carl Colin

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8/17,9/23 6) ☐ Other:

DETAILED ACTION

1. In response to a pre-amendment filed on 8/17/2001, Applicant cancels claims 1-18 and adds claims 19-36. Pursuant to USC 131, claims 19-36 are presented for examination.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: for instance, “storage field 4” on page 5, line 12 in figure 2; “reader 26” on page 6, line 6.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 1 is objected to for lack of indentation of limitation. See MPEP § 608.01(m). Appropriate correction is required.

Art Unit: 2136

3.1 Claims 27, 28, 33, and 36 are objected to because of the following informalities: the term “adapted to” is not a positive limitation and should be corrected. Appropriate correction is required. See MPEP § 2106.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.1 **Claims 19-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,442,345 to **Mollier et al.** in view of US Patent 4,386,266 to **Chesarek** and in view of US Patent 6,169,975 to **White et al.**

4.2 **As per claims 19 and 27, Mollier et al.** substantially discloses a system for activatable documents comprising: a document, wherein arranged on a substrate of the document is an at least machine-readable document number, an optical marking with a machine-readable identification and a storage field for receiving an at least machine-readable check number, for

Art Unit: 2136

example (see column 5, lines 20-66); **Mollier et al.** discloses a recycling apparatus that meets the recitation of a validation device comprising a transport device for receiving the document without a check number, a computing unit with an input keyboard, a recording means and an optical reader for mechanically reading off the identification, wherein the recording means, the input keyboard and the optical reader are connected to the computing unit, for example (see column 8, lines 3-58 and figure 2). **Mollier et al.** also discloses the reading and writing means on a microchip on the card but does not explicitly disclose using cryptography to generate the check number. Many cryptographic methods are well known in the art in providing security. **Chesarek** in an analogous art discloses using first secret key for encryption of at least two parameters for producing the check number and the verification means using a second key and display means for representing the result of the authenticity check and/or a signal line for the delivery of a permission signal, for example (see columns 1-4). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of **Mollier et al.** to include the validation and verifying step as taught by **Chesarek**. This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **Chesarek** so as to provide more security to the transaction system.

White et al. in an analogous art discloses recording a document number into a storage field on a substrate of a card without a number in order to prevent unauthorized personnel from being able to access the card without a proper code, for example (see column 2, lines 5-67; column 12, lines 32-65). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of **Mollier et al.** to write a document

Art Unit: 2136

number into a storage field on a substrate of a card for activation of the document as taught by **White et al.** This modification would have been obvious because one skilled in the art would have been motivated by the suggestions provided by **White et al.** so as to prevent unauthorized personnel from being able to access the card without a proper code.

Claims 20-26 disclose the same inventive concept as discussed in claims 19 and 27 above. Therefore, claims 20-26 are rejected on the same rationale as the rejection of claim 19 and 27.

As per claims 28-33, claims 28-33 recite the same inventive concept as discussed in claims 19 and 27 above. **Chesarek** further discloses manual input of the parameters for the cryptographic operation to the computing unit, using a keyboard, wherein the parameters include at least the document number and the check number, for example (see columns 1-4). Therefore, claims 28-33 are rejected on the same rationale as the rejection of claim 19 and 27.

As per claims 34-36, **Chesarek** discloses the limitation of wherein the computing unit in the validation device is such that upon encryption of the check number a personal identification number of an authorized person which is inputted by way of an input keyboard is incorporated as a parameter for production of the check number and that the verifier produces the permission signal in the computing unit only when in the authenticity checking procedure the personal identification number is incorporated by way of the input keyboard of the verifier in the computing unit as a parameter of the cryptographic operation wherein at least one validation

Art Unit: 2136

device and at least one verifier are connected by way of a network to a central computer for bidirectional data exchange, wherein the at least one verifier is connected by way of a signal line to a service apparatus and that the service apparatus is adapted to enable a service, by means of the permission signal sent to the service apparatus by way of the signal line, for example (see column 6). Therefore, claims 34-36 are rejected on the same rationale as the rejection of claim 19 and 27.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl Colin whose telephone number is 703-305-0355. The examiner can normally be reached on Monday through Thursday, 8:00-6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

cc

Carl Colin

Patent Examiner

October 15, 2004

E. L. Moise
EMMANUEL L. MOISE
PRIMARY EXAMINER